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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/727,144	12/02/2003	David K. Swanson	03-0117 (US01)	5308
41696	7590	01/18/2008		
VISTA IP LAW GROUP LLP 12930 Saratoga Avenue Suite D-2 Saratoga, CA 95070			EXAMINER ROANE, AARON F	
			ART UNIT 3739	PAPER NUMBER
			MAIL DATE 01/18/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/727,144	Applicant(s) SWANSON ET AL.	
	Examiner Aaron Roane	Art Unit 3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 and 38-52 is/are pending in the application.
- 4a) Of the above claim(s) 9, 12, 19, 21, 23, 44 and 46 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10, 11, 13-18, 20, 22, 38-43, 45 and 47-52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>11/8/2007</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

The Information Disclosure Statement filed 11/8/2007 contains references that do not have their dates reported, consequently, those references have not been considered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8, 13-18, 22, 38-43, 45, 47-49 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Francischelli et al. (USPN 6,807,968) in view of Tetzlaff et al. (USPN 6,277,117) in further view of Hooven (USPN 6,889,694).

Regarding claims 1, 14-18, 38, 40, 41, 43 Francischelli et al. disclose an ablating/coagulating forceps apparatus comprising an insulative base member (27 or analogous counterparts in other embodiments) defining a groove; a support member (24

or analogous counterparts in other embodiments), the groove formed within the base member being configured to receive the support member; a coagulation element or means for transmitting coagulation energy, in the form of an electrode (32B or analogous counterparts in other embodiments) carried by the support member, see col. 2, line 47 through col. 4, line 59 and figures 1-5B. It should be further noted that Francischelli et al. disclose a source of coagulation energy, a clamp with first and second clamp members movable with respect to one another via a movement apparatus (pivot), see above cited passage. Francischelli et al. fail to disclose the mating structure is configured for removably securing the base member to the first clamp member. Francischelli et al. also fail to disclose a stimulation element or means for transmitting stimulation energy carried by the support member and a source of stimulation energy. Tetzlaff et al. also disclose an ablating/coagulating forceps apparatus (10) and teach providing an insulative base member (121) with a mating structure (collection of 122 and 124) that is removably securable to the clamp member in order to provide the device with a removable/replaceable electrode assembly, see col. 3-6 and figures 1-7. Hooven also discloses an ablating/coagulating forceps apparatus (70) and teach providing a stimulation element, in the form of an electrode (pacing electrode, 172) along with the source of stimulation energy (inherent) in order to verify ablating/coagulating quality, see col. 15-16 and figures 66 and 67. Therefore at the time of the invention it would have been obvious to one of ordinary skill in the art to modify the invention of Francischelli et al., as taught by Tetzlaff et al., to provide an insulative base member with a mating structure that is removably securable to the clamp member in order to provide the device

with a removable/replaceable electrode assembly, and as further taught by Hooven, to teach provide a stimulation element along with a source of stimulation energy, in the form of an electrode in order to verify ablating/coagulating quality.

Regarding claims 2, 3, 48 and 49 Francischelli et al. in view of Tetzlaff et al. in further view of Hooven disclose the claimed invention, see Tetzlaff et al. figures 1-7.

Regarding claims 4-8, 39, 42 Francischelli et al. in view of Tetzlaff et al. in further view of Hooven disclose the claimed invention.

Regarding claims 13, 22, 45 and 52, Francischelli et al. in view of Tetzlaff et al. in further view of Hooven disclose the claimed invention.

Claims 10, 20 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Francischelli et al. (USPN 6,807,968) in view of Tetzlaff et al. (USPN 6,277,117) in further view of Hooven (USPN 6,889,694) as applied to claims 1, 14 and 47 above, and further in view of being extremely well known in the art.

Regarding claims 10, 20 and 50, Francischelli et al. in view of Tetzlaff et al. in further view of Hooven disclose the claimed invention except for explicitly reciting first and second coagulation element wires connected to the coagulation element. It is extremely well known in the art to provide a coagulating element with first and second wires in

order to transmit energy and cause coagulation. Therefore the examiner takes official notice of the first and second coagulation element wires connected to the coagulation element.

Claims 11 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Francischelli et al. (USPN 6,807,968) in view of Tetzlaff et al. (USPN 6,277,117) in further view of Hooven (USPN 6,889,694) as applied to claims 1 and 47 above, and further in view of being extremely well known in the art.

Regarding claims 11 and 51, Francischelli et al. in view of Tetzlaff et al. in further view of Hooven disclose the claimed invention except for explicitly reciting the stimulation element is located distally with respect coagulation element. Pending a statement of criticality the presently claimed location of the stimulation element is considered to be an obvious design choice over the location disclosed by Francischelli et al. in view of Tetzlaff et al. in further view of Hooven and is not patentably distinct thereover.

Response to Arguments

Applicant's arguments with respect to claims 1-8, 10, 11, 13-18, 20, 22, 38-43, 45 and 47-52 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron Roane whose telephone number is (571) 272-4771. The examiner can normally be reached on Monday-Thursday 7AM-6PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Aaron Roane
January 10, 2008




ROY D. GIBSON
PRIMARY EXAMINER